The opinion in support of the decision being entered today was <u>not</u> written for publication and is <u>not</u> binding precedent of the Board.
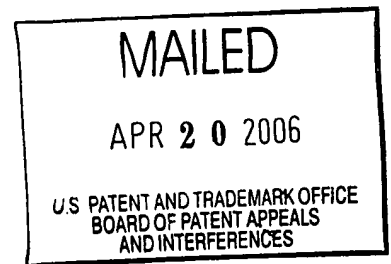
UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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<u>Ex parte</u> JEFFREY H. MICHAUD and DOUGLAS K. OLSON

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Appeal No. 2006-0751
Application No. 09/058,496

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ON BRIEF

_____

Before KRASS, JERRY SMITH and BARRY, <u>Administrative Patent Judges</u>.

JERRY SMITH, <u>Administrative Patent Judge</u>.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-9, 12, 13, 15, 16, 20-22, 24, 25, 28-36 and 38-43. Pending claims 37 and 44 have been indicated by the examiner to contain allowable subject matter.

The disclosed invention pertains to a method and apparatus for associating an area or "hot spot" and a corresponding action with a selected layer of an electronic artwork. The action is assigned to the area and defines a function that is to be activated when the area is selected.

Representative claim 1 is reproduced as follows:

1. A method comprising:

receiving from a user an input selecting a layer in an electronic artwork having a plurality of layers, each layer including image data, the image data of the selected layer including opacity data;

using the opacity data of the selected layer to identify one or more non-transparent regions;

calculating a perimeter boundary of the one or more non-transparent regions;

using the perimeter boundary to define an area in the selected layer;

assigning an action to the area, the action defining a function that is to be activated when the area is selected; and

associating the area and the action with the selected layer as a property of the selected layer in the electronic artwork.

The examiner relies on the following references:

Habermehl	5,956,701	Sep. 21, 1999
		(filed June 13, 1997)
Nielsen	5,991,781	Nov. 23, 1999
		(filed Sep. 27, 1996)
White et al. (White)	6,034,689	Mar. 07, 2000
		(filed June 03, 1996)

Mapedit Imagemap Editing Software(Mapedit), Version 2.3 for Windows 3.1, 1997 by Boutell.com, Inc., URL:http://www.boutell.com/mapedit, pages 1-23.

Claims 1-5, 7-9, 12, 13, 20-22, 29, 30, 35, 36, 42 and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Mapedit in view of White. Claims 15, 16, 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Mapedit in view of White and

further in view of Nielsen. Claims 6, 28, 31-34 and 38-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Mapedit in view of White and further in view of Habermehl.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the

examiner is expected to make the factual determinations set forth

in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467

(1966), and to provide a reason why one having ordinary skill in

the pertinent art would have been led to modify the prior art or

to combine prior art references to arrive at the claimed

invention. Such reason must stem from some teaching, suggestion

or implication in the prior art as a whole or knowledge generally

available to one having ordinary skill in the art. Uniroyal,

Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434,

1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil,

Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227

USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017

(1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572,

1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the

examiner are an essential part of complying with the burden of

presenting a prima facie case of obviousness. Note In re

Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir.

1992). If that burden is met, the burden then shifts to the

applicant to overcome the prima facie case with argument and/or

evidence. Obviousness is then determined on the basis of the

evidence as a whole and the relative persuasiveness of the

arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ

685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472,

223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d

1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments

actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

We consider first the rejection of 1-5, 7-9, 12, 13, 20-22, 29, 30, 35, 36, 42 and 43 based on Mapedit and White. The examiner has indicated how the invention of these claims is deemed to be rendered obvious by the applied prior art [answer, pages 3-7]. With respect to independent claim 1, appellants argue that Mapedit and White fail to teach the receiving and using steps as set forth in claim 1. Specifically, appellants argue that neither reference teaches multiple layers having image data, at least one of which has opacity data. Appellants assert that there is no opacity data disclosed in Mapedit and therefore no opacity data is used to identify non-transparent regions. Appellants also argue that the scaling taught by White does not calculate a perimeter boundary of non-transparent regions as claimed [brief, pages 4-7].

The examiner responds that the overlapping regions of Mapedit can be considered layers. The examiner asserts that Mapedit teaches image data since it can display the reverse video of a region. The examiner also asserts that translucency is a degree of opaqueness and is non-transparent. The examiner notes that the perimeter boundary in Mapedit can constitute the claimed boundary and that claim 1 does not preclude a boundary from being

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defined from the beginning of the claim [answer, pages 10-11].

Appellants respond that the examiner has misconstrued the meaning of opacity data. They assert that displaying a user defined region in reverse video is not using the opacity data of the selected layer to identify one or more non-transparent regions as claimed [reply brief].

We will not sustain the examiner's rejection of claim 1 for essentially the reasons argued by appellants in the briefs. Although the examiner was correct in trying to give claim 1 its broadest reasonable interpretation, the examiner has interpreted the claim to the point where critical language of the claim has been ignored. Although an image may inherently have opacity, we agree with appellants that there is no opacity data in Mapedit which is used to identify one or more non-transparent regions as claimed. We also agree with appellants that there is no calculation of a perimeter boundary in Mapedit nor any suggestion to calculate a perimeter boundary in Mapedit from the teachings of White. Although Mapedit can assign hot spots to a displayed image, Mapedit does not teach the technique recited in claim 1 with or without the additional teachings of White.

Since independent claim 5 contains recitations similar to claim 1, we also do not sustain the rejection of claim 5. Since claims 2-4, 7-9, 12, 13, 20-22, 29, 30, 35, 36, 42 and 43 depend from either claim 1 or claim 5, we also do not sustain the examiner's rejection of any of these claims.

We now consider the rejection of claims 15, 16, 24 and 25 based on Mapedit, White and Nielsen and the rejection of claims 6, 28, 31-34 and 38-41 based on Mapedit, White and Habermehl. Since neither Nielsen nor Habermehl overcomes the deficiencies in the basic combination of Mapedit and White discussed above, we also do not sustain the examiner's rejection of each of these claims.

In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-9, 12, 13, 15, 16, 20-22, 24, 25, 28-36 and 38-43 is reversed.

REVERSED

ERROL A. KRASS   )
Administrative Patent Judge   )
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)
) BOARD OF PATENT
JERRY SMITH   )   APPEALS
Administrative Patent Judge   )   AND
)   INTERFERENCES
)
)
)
LANCE LEONARD BARRY   )
Administrative Patent Judge   ))

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